REMARKS

In an Office Action mailed June 10, 2004, the Examiner withdrew claim 53 from further consideration. The Examiner also maintained the enablement rejection against claims 1, 2, 4, 10-14, and 17-19 and raised a new indefiniteness rejection against claims 3 and 48. Claims 5-9 and 49-52 were indicated as allowable if rewritten in independent form. Each issue raised by the Examiner is considered separately below.

Withdraw Of Claim 53 Under 37 C.F.R. §1.142(b)

The Examiner withdrew claim 53 from further consideration alleging that the claim is directed at non-elected subject matter. The applicants respectfully disagree. Claim 53 was added as the independent form of claim 9 after the Examiner indicated in the previous office action that claim 9 would be allowable if rewritten in independent form. Accordingly, claim 53 is directed at an elected subject matter that the Examiner had already examined and allowed. Reconsideration of the withdraw of claim 53 is respectfully requested.

Rejections Under 35 U.S.C. §112, First Paragraph

The Examiner maintained the rejection against claims 1, 2, 4, 10-14 and 17-19 alleging that these claims are not enabled with respect to "other suitable lipoxygenase inhibitors" not listed in claims 3 and 9. The applicants strongly disagree.

The claims at issue are directed at methods of controlling animal body fat. With respect to lipoxygenase inhibitors, the methods involve administering a lipoxygenase inhibitor to an animal in an amount sufficient to control body fat. In the specification, the applicants provide 26 compounds as examples of lipoxygenase inhibitors. The skilled artisan is familiar with other lipoxygenase inhibitors and will certainly become familiar with any newly identified lipoxygenase inhibitors. It is clearly within the capability of the skilled artisan to administer a lipoxygenase inhibitor to an animal. Therefore, the claims are enabled.

The Examiner is concerned that the specification does not provide sufficient information to allow the skilled artisan to ascertain the compounds that are lipoxygenase inhibitors. The applicants note here that lipoxygenase is a well-known enzyme and that lipoxygenase inhibitors are well known in the art. As such, one or more examples in the specification has been deemed adequate to support the use of an inhibitor in general under the U.S. patent law. For example, in *In re Herschler*, 591 F.2d 693 (CCPA 1979), the court

found adequate support for broad claims to processes for topically administering a physiologically active steroidal agent to a human or animal by concurrently administering the steroidal agent and DMSO, even though the specification disclosed only one example of a "physiologically active steroidal agent" because numerous physiologically active steroidal agents were known to the skilled artisan. This holding is recently upheld by the Federal Circuit in University of Rochester v. G.D. Searle & Co., Inc., 358 F.3d 916, 928 (Fed. Cir. 2004). With regard to lipoxygenase inhibitors not yet identified, the Federal Circuit has held that the enablement requirement is not applicable to future technologies. *Chiron Corporation v. Genentech Inc.*, 363 F.3d 1247 (Fed. Cir. 2004).

Consistent with the above case law, the U.S. Patent and Trademark Office considers patentable claims that recite using any inhibitor to an enzyme if a few examples are provided in the specification, as illustrated in many recently issued U.S. patents. For lipoxygenase inhibitors in particular, the applicants respectfully direct the Examiner's attention to U.S. Patent Nos. 6,756,399; 6,455,541; 6,376,528; 6,191,169; 6,187,756; 6,136,839; and 5,928,654. Each of these patents includes claims directed to use of any lipoxygenase inhibitor, even though the specification names only a few examples.

For the above reasons as well as those provided in the previous response, reconsideration and withdrawal of the enablement rejection is respectfully requested.

Rejections Under 35 U.S.C. §112, Second Paragraph

The Examiner rejected claims 3 and 48 alleging that "BHA" and "BHT" recited in the claims are trademarks/trade names. The applicants hereby clarify that "BHA" and "BHT" are not trademarks or trade names but art-accepted acronyms for "butylated hydroxyanisole" and "butylated hydroxytoluene." For example, "BHA" and "BHT" are identified as "butylated hydroxyanisole" and "butylated hydroxytoluene" in chemical dictionaries and textbooks (see e.g., Hawley's Condensed Chemical Dictionary, 12th ed., Van Nostrand Reinhold Co., NY, 1993, pp.142 and 143; and Organic Chemistry (John McMurry, Cornell University), 3rd ed., Brook/Cole Publishing Co., CA, 1992, p.1013 and index) as well as scientific publications (see e.g., Pillai, S.P. et al., J Environ Pathol Toxicol Oncol. 1999, 18:147-58, Abstract; Murcia, M.A. et al., J Agric Food Chem. 2004, 52:1872-81, Abstract; and Saito, M. et al., Anticancer Res. 2003, 23:4693-701, Abstract) and patent documents (see e.g., U.S. 6,784,204, column 5, line 5; U.S. 6,784,178, column 7, lines 43 and 44; and U.S. 6,783,968,

lines 13 and 14). Reconsideration of the indefiniteness rejection is respectfully requested.

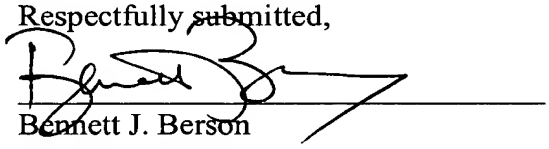
Allowable Subject Matter

The Examiner indicated that claims 5-9 and 49-52 are allowable if rewritten in independent form. The applicants note that claims 49-53 are the independent form of claims 5-9 and are thus believed to be in condition for allowance. The applicants further note that if the Examiner is persuaded upon reconsideration of the rejections under §112, 1st paragraph, then claims 49-53 will be unnecessary.

In view of the remarks provided above, applicants respectfully request that the enablement and indefiniteness rejections be canceled and a Notice of Allowance be issued for claims 1-14, 17-19 and 48-53.

No extension of time is believed to be necessary and no fee is believed to be due in connection with this response. However, if any extension of time is required in this or any subsequent response, please consider this to be a petition for the appropriate extension and a request to charge the petition fee to the Deposit Account No. 17-0055. No other fee is believed to be due in connection with this response. However, if any fee is due in this or any subsequent response, please charge the fee to the same deposit account.

Respectfully submitted,



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